

REMARKS

The Applicant requests entry of the above Amendments, and consideration of the application, as amended.

By these Amendments, the Applicant has amended claims 18, 19, and 30 to overcome §112 rejections that appear in the Office Action. The Applicant has also amended claims 26, 37, and 45 to limit the first material to a "textile" material. Support for this aspect of the invention is found throughout the instant Specification.

The Applicant also introduced new claims 57-69. New claim 57 corresponds to allowed claim 24 redrafted in independent form. New claim 60 corresponds to allowed claim 25. New claims 58 and 59 have bases in as-filed claims 21 and 22, respectively, and throughout the instant Specification.

New claim 61 corresponds to allowed claim 31 redrafted in independent form. New claim 63 corresponds to allowed claim 32. New claims 62 and 64 have bases in as-filed claims 27 and 14, respectively, and throughout the instant Specification.

New claim 65 corresponds to allowed claim 44 redrafted in independent form. New claims 66, 67, 68, and 69 have bases in as-filed claims 32, 38, 39, and 21, respectively, and throughout the instant Specification.

In making the above amendments, the Applicant in no way acquiesces to the rejections made by the Patent Office in the Office Action. The Applicant reserves the right to pursue protection of the broader invention recited in the as-filed claims through one or more divisional or continuation applications, as appropriate, at a later time. The Applicant submits that no new matter was introduced to the claims by the above amendments. Claims 1 through 69 are now pending in this application.

Response to Comments in Office Action

Rejections §112 Rejections due to Indefiniteness

In paragraphs 1-4 on page 2 of the Action, the Patent Office rejected claims 18, 19, and 30 under 35 U.S.C. §112, second paragraph, as being indefinite. The Applicant believes that the above amendments overcome these rejections.

Rejections §102 Rejections due to Anticipation

In paragraphs 5-8 on pages 2 through 5 of the Action, the Patent Office rejected claims 26-28, 33, 34, 36-41, 45-47, 50 and 53 under 35 U.S.C. §102(b), as anticipated by each of U.S. Patent Des. 381,211 of Aries, et al. [herein "Aries"]; U.S. Patent Des. 387,567 of Queen [herein "Queen"]; and U.S. Patent Des. 431,909 of Henry, et al. [herein "Henry"]. However, the Applicant respectfully submits that these rejections are inappropriate in view of the above amendments and requests that these rejections be reconsidered and withdrawn in view of the following comments.

The MPEP § 2131 defines the conditions under which an anticipation rejection is appropriate:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim..."

The Applicant submits that Aries, Queen, and Henry do not disclose "each and every element" of the claimed invention, as amended, nor do Aries, Queen, and Henry show

the claimed invention, as amended, "in as complete detail" as claimed, and, therefore, Aries, Queen, and Henry do not anticipate these claims, as amended.

The Applicant has amended independent claims 26, 37, and 45 to include the limitation that the first material comprise a "textile" material. As readily understood in the art, and as defined, for example, by Merriam-Webster's On-line dictionary, the term "textile" means:

- 1: cloth, 1a; especially: a woven or knit cloth
- 2: a fiber, filament, or yarn used in making cloth

As noted by the Patent Office in the last paragraph on page 4 of the Action, Aries, Queen, and Henry disclose a record, a patent, and a medical certificate, respectively. The Applicant submits that these materials are not textile materials, as claimed. Therefore, the Applicant submits that Aries, Queen, and Henry do not anticipate the inventions recited in claims 26, 37, and 45. The Applicant requests that these claims be reconsidered in light of the above amendment and the rejection of these claims as anticipated by Aries, Queen, and Henry be withdrawn.

In addition to not anticipating the inventions of amended claims 26, 37, and 45, the Applicant also submits that Aries, Queen, and Henry do not anticipate the claims dependent upon claims 26, 47, and 45 for the same reasons claim 26, 37, and 45 are not anticipated by Aries, Queen, and Henry. The Applicant respectfully requests that these rejections be reconsidered and withdrawn.

Rejections §103 Rejections due to Obviousness

In paragraphs 9 and 10 on pages 5 and 6 of the Action, the Patent Office rejected claims 1-18, 20-23, 26-30, 33-43, and 45-53 under 35 U.S.C. §103(a) as obvious in view of U.S. Patent 5,461,748 of Koiduka [herein "Koiduka"]. However, the Applicant respectfully submits that these rejections are inappropriate and requests that these rejections be reconsidered in view of the following comments and observations.

MPEP 2104.02 provides the following guidelines when considering the obviousness of a claimed invention in view of the prior art:

In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983) [Emphasis added.]

and

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) [Emphasis added.]

and

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). [Emphasis added.]

The Applicant submits that Koiduka not only does not disclose, teach, or even suggest the claimed invention as a whole, but Koiduka actually teaches away from the claimed invention. Therefore, the Applicant respectfully submits that the claimed invention is not obvious in view of the teachings of Koiduka.

In paragraph 6 on pages 3 and 4 of the Action, the Patent Office sufficiently summarized several aspects of the present invention; so, for the sake of brevity, the Applicant will not reiterate a description of the invention here. However, the Applicant highlights one aspect of the invention that was acknowledged by the Patent Office in paragraph 6 that is pertinent to the following discussion.

According to the present invention, for example, as recited in independent claims 1, 10, 15, 20, 26, 37, and 45, and acknowledged in paragraph 6 of the Office Action, the “second region” provides “at least some information related to the image on the first region” [Emphasis added.]. The Applicant submits that Koiduka does not disclose, teach, or in any way suggest that a second region have this “at least some information related to the image on the first region”. Again, the Applicant submits that Koiduka does not disclose, teach, or even suggest the claimed invention as a whole.

In support of this position, the Applicant believes that it will be instructive to review the teachings of Koiduka. As correctly stated by the Patent Office, Koiduka does disclose “a floor mat”. As recited in column 1 of Koiduka, under the heading “Field of the Invention”, the mat of Koiduka is described as “a mat for removing mud and dirt sticking to footwear” and, more specifically, “the present invention relates particularly to a mat or a mat with a name seal and a method for anchoring a name on a mat that is suitable for rental.” [Emphasis added.] Under the heading “Brief Description of the Prior Art”, Koiduka then continues to describe the limitation of the prior art “rental mats”, in particular, the difficulty that the prior art encounters in affixing a “name seal” to the rental map. As described throughout Koiduka, for example, at 2:61-63, a “name seal 5” appears to be simply a strip of PVC thermoplastic having a customer’s name. Under the heading “Summary of the Invention”, Koiduka addresses the problem of attaching name seals by providing a “method of anchoring the name seal” (2:1-9). Clearly the invention of Koiduka simply deals with a method of attaching labels having names to floor mats. However, the Applicant respectfully submits that Koiduka does not disclose, teach, or in anyway suggest the invention recited in the present claims.

In the Patent Office’s summary of the present invention, in paragraph 10 of the Action, the Patent Office appears to have completely missed the very essence of the invention: “...a second material having at least some information related to the image on the first region”. This feature of the invention is common throughout the claims that were rejected due to obviousness based upon Koiduka. However, Koiduka does not

disclose, teach, or in anyway suggest this aspect of the present invention. The Patent Office notes that Koiduka does not include an image. The Applicant agrees with this assessment of Koiduka, except for the mention of a design on the name seal, discussed below. The Patent Office then contends that "it is well-known in the art of floor mats to include images". The Applicant does not refute that the use of images may be well-known in the art, but the present invention is not limited to simply using images. The present invention includes an image on a region and information related to the image on another region. Again, this feature is not only missing from Koiduka, but Koiduka in no way suggests that information related to the image be placed anywhere on the mat of Koiduka. Again, the "name seal" of Koiduka only includes a "manufacture's name", it does not contain any information related to any image on the mat. This is, of course, understandable, since no images appear on the mat of Koiduka. Thus, even if an image did appear on the mat of Koiduka, the present invention is not provided.

With respect to the invention recited in claim 1, first, Koiduka does not include a "first region comprising a first material having an image", according to the present invention. Again, nowhere in Koiduka is it disclosed that the "planting portion 3" or "edge portion 6" have any graphic or picture that in anyway can be considered an image. The only mention in Koiduka of any graphic that could be interpreted as an image is found at 1:59-62, where the inventor states that the strip of thermoplastic resin (9a), upon which the name seal (5) is mounted, can include "coloring and design, which do not impede name display". However, as will be addressed shortly, there is no second region of the mat of Koiduka that provides any information related to this "coloring and design", as claimed.

Second, there is no second region of the mat of Koiduka "having at least some information related to the image on the first region", as claimed. Contrary to the present invention, Koiduka discloses only one region that contains any information at all. Koiduka discloses that the "name seal 5" contains the name of a customer. The Applicant submits that there is absolutely no disclosure or suggestion in Koiduka that the "name seal" contain any information whatsoever concerning any "image" displayed

on any other region of the mat of Koiduka, as in the present invention. Clearly, there is no relationship in Koiduka between the only "image" of Koiduka, that is, the "coloring and design" that may appear on the thermoplastic resin (9a), and the customer name on the name seal (5). Therefore, the Applicant submits that the invention of claim 1 is non-obvious in view of Koiduka and the Applicant requests that this rejection be reconsidered and withdrawn.

Similarly, the Applicant submits that the inventions recited in the claims dependent upon claim 1, that is, claims 2-9, 51, and 54, are non-obvious for the same reasons claim 1 is non-obvious. Moreover, the Applicant submits that certain aspects of the invention recited in claims 2-9, 51, and 54 are also clearly not obvious in view of Koiduka. For example, with respect to claim 3, nowhere does Koiduka disclose, teach, or suggest that that any first region (that is, the region having the image) have a void and the second region containing the information is positioned in that void. The Applicant respectfully requests that these rejections be reconsidered and withdrawn.

With respect to the rejection of claims 10 and its dependent claims 11-14 based upon Koiduka, the same response applies. The Applicant submits that these claims are also non-obvious for the same reasons claim 1 is non-obvious. The Applicant respectfully requests that these rejections be reconsidered and withdrawn.

With respect to the rejection of claims 15 and its dependent claims 16-18 based upon Koiduka, the same response applies. The Applicant submits that these claims are also non-obvious for the same reasons claim 1 is non-obvious. Specifically, with respect to claim 15, Koiduka does not disclose the steps of providing a first material, providing an image on a region of the first material, providing a void in the region, mounting a second material, having information about the image, in the void. Also, with respect to claim 18, Koiduka does not disclose, teach, or suggest the removal of material from the substrate in the first region to provide the void in the first region. In response to the comments made in the last paragraph of the Office Action by the Patent Office, the cited passage (3:28-31) discloses that the resin element 9a may be "at the same level of the surface of the mat", but Koiduka does not disclose or suggest

that material be removed to provide this. Koiduka also does not locate the element 9a in the region 3 in a manner anyway related to the present invention. Furthermore, based upon what is disclosed by Koiduka as a whole, there is no motivation to locate the element 9a in the main region 3 of Koiduka. Thus, the Applicant submits that the inventions recited in claims 15-18 are not obvious in view of Koiduka, and the Applicant respectfully requests that these rejections be reconsidered and withdrawn.

With respect to the rejection of claim 20 based upon Koiduka, the Applicant submits that the invention recited in claim 20 is also non-obvious for the same reasons the invention of claim 1 is non-obvious. Moreover, the Applicant submits that Koiduka does not disclose, teach, or suggest that the mat of Koiduka is a "tufted carpet", as claimed. According to the accepted meaning in the art, the term "tufted", as defined on-line by Dupont [<http://www1.dupont.com>], one of the leading manufacturers of materials for carpets, means

Tufted carpet

Carpet produced by a tufting machine instead of a loom.

Tufting

A method of carpet manufacture in which surface yarns are sewn or "punched" through a primary backing material. The needles of the tufting machine form loops which are hooked by loopers on the underside of the backing material and which remain loops in level or textured loop carpet. Alternatively, the loops are tufted and cut with knives to create cut pile carpet. The tufted fabric is then coated with an adhesive to adhere a secondary back to provide durability and stability

The mat of Koiduka is not a tufted carpet; in Koiduka, no threads or yarns are drawn through any structure that can be considered a backing material. In the first sentence of the last paragraph on page 5 of the Action, the Patent Office cites the passage at 2:24-38 of Koiduka in support of the Patent Office's contention that Koiduka discloses a "tufted" mat. This cited passage is reproduced here to aid this discussion;

The mat 1 is, as shown in FIG. 1, formed in which the mat main body 2 is formed in a sheet shape by curing raw rubber, and the planting portion 3 formed into a

brush shape with nylon fibers is fixed on the whole surface with an edge portion 6 left. [Emphasis added.]

Clearly, the “planting portion 3” of Koiduka is not “tufted”, as known in the art, but a mat formed by “fixing” fibers into a sheet of “curing raw rubber”. Unlike the process of tufting as known in the art, the fibers of Koiduka are not drawn through a fabric, in contrast to the present invention, but molded into a rubber substrate. This feature of Koiduka is also illustrated in the detailed views shown in Figures 2b and 2d of Koiduka. As shown in these detailed views, planting portion 3 is imbedded into mat main body 2, not drawn through a fabric as in tufting as claimed. Again, the Applicant respectfully submits that since the tufted carpet recited in claim 20 is not disclosed, taught or suggested by Koiduka and there is no motivation in Koiduka to employ tufting, the invention of claim 20 is not obvious in view of Koiduka. The Applicant respectfully requests that for this reason alone this rejection be reconsidered and withdrawn.

However, there are also further distinctions between the tufted carpet recited in claim 20 and Koiduka. Specifically, nowhere in Koiduka is a “textile” material provided for mounting in the second region. In the next to last paragraph on page 6 of the Action, the Patent Office acknowledges that Koiduka does not teach that the name plate of Koiduka is made from a textile. The Applicant concurs. However, the Patent Office contends that it would be obvious to use a textile name plate in the invention of Koiduka. The Applicant respectfully submits that employing a textile nameplate is not only not disclosed by Koiduka, but the use of a textile nameplate would contradict the teachings of Koiduka taken as a whole.

As discussed above, the invention of Koiduka attempts to address an existing problem in the art, that is, the difficulty that the prior art encounters in affixing a “name seal” to the rental map. Under the heading “Summary of the Invention”, Koiduka addresses the problem of attaching name seals by providing a “method of anchoring the name seal” (2:1-9). According to the invention of Koiduka, as described at 1:55-67:

For achieving the object mentioned above, an element of thermoplastic resin as a base material for anchoring the name is integrated with the mat main body formed by curing raw rubber....

For a mat with name, a mat integrated with an element of thermoplastic resin for the base material for anchoring the name on the mat main body formed by curing raw rubber is used, and a thermoplastic resin seal with name is adhered on the element of thermoplastic resin of the mat main body. [Emphasis added.]

Also, as described at 2:64-3:1, the specific thermoplastic resin material is ideally suited to the disclosed invention:

The thermoplastic resin seal with specified name 5 is firmly welded onto the surface of the thermoplastic resin 9a of the mat main body 2 to provide the mat with a name by directing onto the seal, a high frequency from a high frequency welder 11 from above. [Emphasis added.]

That is, the material of the name seal was specifically chosen by Koiduka to permit the "welding" of the seal to the mat. Clearly, the thermoplastic resin of Koiduka was especially chosen to be able to be welded to and adhere to the rubber mat of Koiduka. Contrary to the comments made by the Patent Office, it is highly unlikely that a name plate made from a textile material could be effectively welded to the mat Koiduka as desired, for example, by "high frequency welding". Therefore, the Applicant submits that the use of a textile material as recited in claim 20, and elsewhere, is not obvious in view of Koiduka. The Applicant respectfully requests that for this reason alone this rejection of claims 20 be reconsidered and withdrawn.

Similarly, the Applicant submits that the inventions recited in the claims dependent upon claim 20, that is, claims 21-23, 52, and 55, are non-obvious for the same reasons claim 20 is non-obvious. The Applicant respectfully requests that these rejections be reconsidered and withdrawn.

With respect to the rejection of claim 26 based upon Koiduka, the Applicant submits that the invention recited in amended claim 26 is also non-obvious for the same reasons the invention of claim 1 is non-obvious. Again, Koiduka does not disclose an article of manufacture having a second region having information related to an image on the first region. Thus, the Applicant submits that the invention recited in claim 26 is not obvious in view of Koiduka, and the Applicant respectfully requests that this rejection be reconsidered and withdrawn.

Similarly, the Applicant submits that the inventions recited in the claims dependent upon claim 26, that is, claims 27-30, 33-36, 53, and 56, are non-obvious for the same reasons claim 26 is non-obvious. Moreover, the Applicant submits that certain aspects of the invention recited in claims 27-30 and 33-36 are also clearly not obvious in view of Koiduka. For example, with respect to claim 29, nowhere does Koiduka disclose, teach, or suggest that that any first region (that is, the region having the image) comprise a tufted material, a woven material, or a non-woven material. As discussed above with respect to claim 20, the mat of Koiduka is not a tufted mat, but a rubber mat into which fibers are imbedded. In addition, the mat of Koiduka is not a woven or non-woven mat, as known in the art. The Applicant respectfully requests that these rejections be reconsidered and withdrawn.

With respect to the rejection of claim 37 based upon Koiduka, the Applicant submits that the invention recited in amended claim 37 is also non-obvious for the same reasons the invention of claim 1 is non-obvious. Again, Koiduka does not disclose an article of manufacture having a second region having information related to an image on the first region. Thus, the Applicant submits that the invention recited in claim 37 is not obvious in view of Koiduka, and the Applicant respectfully requests that this rejection be reconsidered and withdrawn.

Similarly, the Applicant submits that the inventions recited in the claims dependent upon claim 37, that is, claims 38-43, are non-obvious for the same reasons claim 37 is non-obvious. Moreover, the Applicant submits that certain aspects of the invention recited in claims 37-43 are also clearly not obvious in view of Koiduka. For example, with respect to claim 42, as discussed above with respect to claim 20, nowhere in Koiduka is the use of a tufted material disclosed, taught, or suggested. Also, with respect to claim 43, as discussed above with respect to claim 15, nowhere in Koiduka is a void provided by removing material from the first region and mounting a textile material in the void. The Applicant respectfully requests that these rejections be reconsidered and withdrawn.

With respect to the rejection of claim 45 based upon Koiduka, the Applicant submits that the invention recited in amended claim 45 is also non-obvious for the same reasons the invention of claim 1 is non-obvious. Again, Koiduka does not disclose an article of manufacture having a second region having information related to an image on the first region. Thus, the Applicant submits that the invention recited in claim 45 is not obvious in view of Koiduka, and the Applicant respectfully requests that this rejection be reconsidered and withdrawn.

Similarly, the Applicant submits that the inventions recited in the claims dependent upon claim 45, that is, claims 46-50, are non-obvious for the same reasons claim 45 is non-obvious. Moreover, the Applicant submits that certain aspects of the invention recited in claims 46-50 are also clearly not obvious in view of Koiduka. For example, with respect to claim 49, nowhere in Koiduka is the use of a woven or non-woven material disclosed, taught, or suggested. As discussed above, the fibers of the planting region 3 of Koiduka are embedded into the rubber substrate of Koiduka, and the rubber substrate also provides the basis for mounting the name 5. If the rubber substrate and embedded fibers were replaced by a woven or non-woven textile as suggested by the Patent Office, it is unclear to the Applicant, for example, how the name 5 of Koiduka can be attached to the woven or nonwoven fabric, especially since the attachment of the name 5 to the rubber mat is the essence of the invention of Koiduka. The Applicant thus submits that the inventions of claims 46-50 are not obvious in view of Koiduka. The Applicant respectfully requests that these rejections be reconsidered and withdrawn.

Allowable Subject Matter

In paragraphs 11 through 14 on page 7 of the Action, the Patent Office acknowledges the allowability of claims 19, 24, 25, 31, 32, 44, and 54-56. The Applicant acknowledges with appreciation the Patent Office's recognition of the allowability of this subject matter. As noted above, the Applicant has introduced new claims 57-69 drawn to the allowable subject matter of claims 24, 25, 31, 32, and 44. However, as discussed above, the Applicant believes that the Applicant is entitled to

Applicants: Calandrino, Sonna
Serial No.: 09/992,136

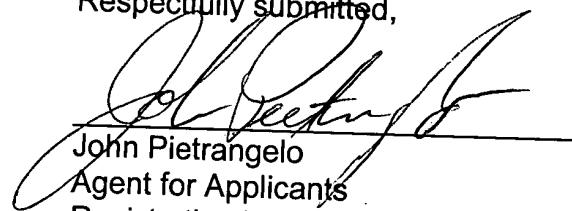
Attorney Ref.: 2022.002

broader protection in view of the cited art.

Conclusion

The Applicant believes that the application is in allowable form. Early passage of the subject application to issue is earnestly solicited. Should any matters remain outstanding, it is requested that the undersigned Agent be given a call so that such matters may be worked out and the patent placed in condition for allowance without the necessity of another Action.

Respectfully submitted,



John Pietrangelo
Agent for Applicants
Registration No. 39,331

Dated: September 24, 2003

HESLIN ROTHENBERG FARLEY & MESITI P.C.
5 Columbia Circle
Albany, New York 12203-5160
Telephone: (518) 452-5600
Facsimile: (518) 452-5579